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REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Examiner's comments in the Office Action mailed July 6, 2005. Applicant respectfully requests reconsideration and favorable action in this case.

Summary of rejections and amendments

Claims 1-3 and 6-23 were pending in the application prior to the Office Action. The Examiner rejected claims 1-3 and 6-23. Claim 19 has been amended, and claims 4-5 and 24-25 have been canceled. New claims 26-34 have been added. Claims 1-3 and 6-34 are therefore pending in the application.

Rejections under 35 U.S.C. § 112

The Examiner rejects claims 1-3 and 6-23 under 35 U.S.C. 112, Second Paragraph, as failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The Examiner states that there is insufficient antecedent basis for the limitation "a method" in claims 1 and 21. It is the Applicant's understanding that an antecedent basis rejection of this type is normally made when the first reference to a limitation in a claim uses a definite article (e.g., "the," "said," or the like,) rather than an indefinite article (e.g., "a," "a plurality of," or the like.) Accordingly, the Applicant does not understand the reasoning behind the Examiner's statement that "Claim 1 and 21 recites the limitation 'A method' in claim. There is insufficient antecedent basis for this limitation in the claim." The Applicant therefore respectfully requests that the Examiner clarify the basis for this rejection, or alternatively withdraw the rejection.

Rejections under 35 U.S.C. § 101

The Examiner rejects claims 1-3 and 6-23 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Applicant respectfully traverses this rejection.

The Examiner states that claims 1-3 and 6-23 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to

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a practical application within the technological arts. The Examiner also indicates that the method must be stored on a computer readable medium and/or executed by a computer.

The Applicant points out that the claims have been amended to explicitly recite a computer-readable medium. The Applicant further points out that the claims are limited to a practical application, and are therefore statutory. In regard to the nature of statutory computer-related methods, the M.P.E.P. states:

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan [], or (B) be limited to a practical application within the technological arts (M.P.E.P. 2106 IV.B.2.(b))

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result (M.P.E.P. 2106 IV.B.2.(b) ii))

Examples of this type of claimed statutory process include the following: - A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available. (M.P.E.P. 2106 IV.B.2.(b) ii))

The claims are examples of methods that optimally control the retrieval of data, namely the identification of a position that is associated with a selected role. The claims therefore recite statutory subject matter as described in M.P.E.P. 2106. Accordingly, the Examiner's rejection is believed to have been overcome.

Rejections under 35 U.S.C. § 103

Claims 1-3 and 6-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,075,851 ("Pinard '851") in view of U.S. Patent No. 6,816,589 ("Pinard '589"). The Applicant respectfully traverses this rejection.

The Examiner states that Pinard '851 discloses all of the limitations of claim 1 except that it does not explicitly indicate "searching a selected role within an organization". The Examiner states that this limitation is instead disclosed by Pinard '589. The Applicant respectfully submits that the combination of these references fails for at least three reasons. First, the references, which concern call screening and telephone equipment allocation, are in arts that are not analogous to the art of the present invention. Consequently, the references cannot be relied upon to support the Examiner's rejection under 35 U.S.C. §103. M.P.E.P. 2141.01(a). Second, the references fail to disclose all of the limitations of the claims and

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therefore fail to support the rejection under 35 U.S.C. §103. M.P.E.P. 2143.03. Third, there is no suggestion in the prior art that it would be desirable to combine the references as suggested by the Examiner. M.P.E.P. 2143.01.

References are not analogous prior art

As noted above, Pinard '851 discloses systems for call screening. In the example presented in this reference, Fred places a call to Mary and the system determines whether the call will be allowed or re-routed to an alternate recipient. Pinard '589 concerns the dynamic allocation of telephone or other communication equipment to predetermined groups of people. Neither reference deals with the identification of persons whose participation is needed for completion of a business process.

As noted in MPEP 2141.01(a), In order to rely on a reference as a basis for rejection of an Applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. The mpep provides the example of Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), in which patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. In this case, a finding that a reference directed to SIMM's for an industrial controller was not analogous was supported by substantial evidence. A person of ordinary skill in the art of the invention, faced with the problem of identifying persons having selected roles for participation in a business process, clearly would not consider call screening and telephone equipment allocation references to be analogous to the art of the invention.

Because the Pinard '851 and Pinard '589 references are not analogous prior art, they cannot be used to support the Examiner's rejection under 35 U.S.C. §103.

References fail to disclose all claim limitations

Claim 1 recites a method comprising:

- (a) identifying the selected role for which the search will be conducted and identifying a first position within the organizational structure from which the search will be started;
- (b) after identifying the selected role and the first position, identifying a second position which is immediately above the first position in the organizational structure;
- (c) making a determination whether the second position is associated with the selected role and

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- terminating the search when the second position is associated with the selected role and
- searching positions below the second position in the organizational structure when the second position is not associated with the selected role; and
- (d) repeating (c) from the second position when the selected role is not found among the positions below the second position in the organizational structure.

The Examiner first states in regard to limitations (a) and (b) of claim 1 that Pinard '851 discloses identifying a first position (Mary) and a second position (Fred) immediately above the first position (citing Figure 2 and col. 3, lines 42-53.) The Applicant points out that Mary is not identified as a position within an organizational structure as recited in the claims -- Mary's user agent (17) simply receives a call from another (Fred's) user agent. Mary's position in the organization is completely irrelevant. Additionally, the first position has been amended in the claim to specify that it is that position from which the search for the selected role will be started. As taught by Pinard '851, Mary's position has nothing to do with looking up the people /phone numbers that are allowed by her call screening. These people/numbers are simply retrieved from Mary's list of allowed callers (Figure 4, col. 3, lines 9-15). Moreover, looking up these numbers has nothing to do with searching for a selected role in the organization.

The only thing in Pinard that could possibly be construed as a search of an organizational structure would be the lookup of the identity of "MY BOSS" in Mary's list of allowed callers. Assuming for the sake of argument that this is the case, the only "search" disclosed by Pinard '851 is the search for the position immediately above Mary. This is not a search for a selected role, but only for a single position immediately above Mary's. In fact, Pinard '851 explicitly points out that "role," as used in the reference, is simply the position of a person in the organization (col. 2, lines 60-65.) Fred's role is irrelevant to the search -- it is only his position above Mary that is significant. When this position is identified, the corresponding information (Fred's phone number) is retrieved. There is no determination whether this position is associated with a selected role. Further, there is no search of positions below this one in the organizational structure when this position is not associated with a selected role, as recited in the claim. Still further, there is no repeated search of the organizational structure when need is position or any of positions under it are associated with a selected role, as also recited in the claim. Consequently, even if it is assumed that limitations (a) and (b) are met (which the Applicant does not believe is the case,) limitations (c) and (d) clearly are not.

The Examiner states that, while Pinard '851 does not explicitly disclose a search for a selected role, Pinard '589 does disclose this. The Examiner states that "the group agent searches through all of the members who have been defined in the role of customer support,

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who are currently active and, utilizing the roles defined by the particular hunt group type, and chooses the appropriate person to send the call to." Pinard '589, however, discloses that a call is directed (according to a particular hunt group number) to a particular hunt group agent (col. 12, lines 17-21,) which selects a member of a corresponding hunt group to take the call. The hunt group agent searches through ALL of the active members of the group (col. 12, lines 28-30.) The selection of one of the group members is based upon the hunt type (e.g., circular, terminal, etc.,) and not upon comparison of a selected role to each position as it is searched in the manner recited in the claim.

The Applicant notes that the use of "roles defined by the particular hunt group type (e.g., circular, terminal, etc.*)" appears to refer only to the type of search (e.g., a circular search, a terminal search, etc.,) as there is no discussion of roles, but there are repeated uses of "hunt type (e.g., circular, terminal, etc.*)" in the same context as used at col. 12, lines 17-35.

Because the Pinard '851 and Pinard '589 references fail to disclose searching a hierarchical organizational structure to find a position associated with a selected role, and doing so in the specific manner discussed in claim 1 (second position, then positions below the second position, then immediately above the second position, then positions below this,) these references fail to disclose all the limitations of the claim and fail to support the Examiner's rejection under §103.

Prior art does not suggest the desirability of the claimed invention

The Examiner states that there are several reasons that it would have been obvious to a person of ordinary skill in the art of the invention to combine the references in the manner suggested by the Examiner. First, the Examiner states that "searching a selected a role within an organization of Pinard ('589) teachings would have allowed Pinard ('851) system dynamically to allocate telephone and other communications equipment to predetermined groups". As noted above, however, Pinard '851 deals with call screening systems. This reference does not in any way concern, or suggest a need for, means to allocate telephone or other communications equipment. This reason for combining the references is therefore without substance.

The Examiner further states that "searching a selected role within an organization as taught by Pinard ('589) improves to provide for assigning to each person within an organization at least one role". As pointed out above, however, the system of Pinard '851 has no need for assigning a role to each person within an organization. In the Pinard '851 system, the use of roles serves to reduce the efficiency of the system by adding an extra step -- the need to

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determine the identity of a person /phone number associated with the role — before a calling number can be compared to the list of allowed callers. Thus, the disclosures of the references actually teach away from their combination.

For these reasons, the Applicant respectfully submits that the Examiner has failed to establish that the prior art suggests the desirability of combining the references as required by M.P.E.P. 2143.01.

For at least the reasons set forth above, claim 1 is patentable over the Pinard '851 and Pinard '589 references. Because claims 2-3 and 6-20 depend from and include all the limitations of claim 1, they are distinguished from these references in the same manner. Nevertheless, the Applicant points out that the dependent claims are distinguished from the references for additional reasons, namely the failure of the references to disclose additional limitations specified in the claims. Some of these shortcomings of the references are pointed below.

As to claim 2, the claim specifies that the first position is a position initiating the business process. The Examiner first states that the selected business process as disclosed by Pinard ('851) is an inter-office calling. The Examiner then states that Mary (the first position) initiates the business process by ordering call screening. Ordering call screening, however, does not initiate Fred's call. Fred's call was placed without regard to whether or not Mary ordered call screening. Fred therefore initiated the process (the call.) so the limitation recited in the claim is not met by the teachings of Pinard ('851).

In regard to claim 3, the claim recites identifying the selected role by identifying a role that is required to authorize the business process. The Examiner states that this limitation is disclosed by Pinard ('851) in that Mary identifies "My Boss" as an allowed caller. "My Boss," however, is not required to authorize the business process. No one in the system of Pinard ('851) is required to authorize the business process. The process proceeds without authorization of any kind. The only entity in Pinard's ('851) process that could arguably be considered to be required to authorize the process would be the call screening system. The call screening system does not, however, give or withhold authorization, it simply routes the call either to Mary or to a default recipient. Moreover, the call screening system does not have a role associated with a position in the Hierarchical organizational structure as recited in the claim. Pinard ('851) therefore fails to disclose the additional limitation of claim 3, and does not support a rejection of the claim under 35 U.S.C. §103.

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Regarding claims 6-7, the claims recite that one or more of the roles associated with the hierarchical organizational structure are not unique. The Examiner states that there may be multiple bosses, so this role is not unique. This is not the case, however, with respect to the process that the Examiner uses as the basis for the rejection of the claim. With respect to this process, there is only one boss – Fred. The process only screens calls to one person – Mary – based on Mary's list of allowed callers. If the Examiner argues that the process can be used by other people in the organization, the Applicant points out that, for each of these people, the process screens calls to that one person, so MY BOSS for that person would be a unique position. If there were more than one position associated with a role such as MY BOSS, it is not clear from the disclosure of Pinard that the system could decide which position and corresponding number would be retrieved.

Regarding claim 8, the claim recites that the positions below the second position are searched in a predetermined manner. The Examiner states that Pinard ('851) shows that a call may be diverted to John, who is at a lower position than Fred. The Applicant points out that the call may be diverted to John because John is listed as temporarily replacing Fred (col. 4, lines 56-65.) There is no search of positions below Fred – there is only a retrieval of information listed in the database with Fred's entry. The disclosed process will retrieve a person's number if it is listed with Fred's, regardless of whether that person is above or below Fred in the organization, and it will be retrieved without searching this person's, or any other person's positions in the organization.

As to claim 9, the claim recites that the hierarchical role structure is distinct from the hierarchical organizational structure. The Examiner states that a role structure which is separate from the organizational structure is disclosed at col. 3, lines 1-3. In fact, this portion of Pinard ('851) states: "... store the relationships of the organization, such as the one shown. The database can store the title or identity of the role, in addition to the name of the incumbent." This in no way teaches the use of a hierarchical role structure which is distinct from a hierarchical organizational structure. Even if, e.g., Jane has a secretarial role, there is no indication whatsoever that there is any kind of hierarchical role structure as recited in the claim. This is further supported by the fact that Pinard explicitly defines "roles" as the people's positions in the organization (col. 2, lines 60-65.)

Regarding claims 10-12, the claims recites one or more of the structures consisting of a hierarchical functional role structure, a hierarchical superiority role structure, and a hierarchical

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legal role structure. As noted above, there is no disclosure in Pinard ('851) of any hierarchical role structure, much less the specific types recited in the claims.

In regard to claims 18-20, the limitations of these claims are similar to those discussed above, so the references fail to disclose the limitations of these claims as discussed above.

Regarding claim 21, the Examiner states that Pinard ('851) states that an additional hierarchical structure of roles are provided," citing col. 3, lines 1-3. As noted above in connection with claim 9, the reference states no such thing. Although Pinard ('851) may disclose that one person may have a secretarial role, there is no disclosure of a role structure separate from the organizational structure, nor is there any disclosure that each position in the organizational structure is associated with a role in the role structure.

In regard to claims 22-23, the limitations of these claims are similar to those discussed above, so the references fail to disclose the limitations of these claims as discussed above.

As set forth above, the Applicant respectfully submits that Pinard '851 and Pinard '589 fail to disclose all of the limitations recited in the claims. It appears that the Examiner has taken isolated pieces of information from the references and has put them together with the benefit of hindsight to reconstruct the claimed invention. As pointed out by the Applicant, the isolated references to Mary's boss and Jane's secretarial position do not constitute disclosure of a hierarchical role structure, particularly one which is separate from the hierarchical organizational structure. Similarly, the simple retrieval of phone numbers for all of Mary's allowed callers to find a match for a calling number does not constitute a search of the hierarchical organization structure for a particular role, as recited in the claims. Because of these shortcomings, the Pinard '581 and '589 disclosures fail to support the Examiner's rejection of the claims under 35 U.S.C. §103.

New claims

The Applicant notes that new claims 26-34 have been added. These claims include limitations that are not disclosed by the references cited by the Examiner and are believed to be allowable over the prior art of record. The total number of independent/dependent claims in the application does not exceed the highest number previously paid for, so the Applicant believes no additional fees are due.

Conclusion

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Applicant has now made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all claims pending in the application. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Applicant does not believe any fees are due at this time. If any extensions of time are necessary to prevent the above referenced application from becoming abandoned, the Applicant hereby requests such extensions. If any fees are inadvertently omitted, or if any additional fees are required, or if any amounts have been overpaid, please appropriately charge or credit those fees to Deposit Account No. 50-3085 of the Law Offices of Mark L. Berrier.

Respectfully submitted,



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